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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/134,831 08/17/98 METTKE

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EXAMINER

WM01/0611

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ART UNIT

PAPER NUMBER

2643

DATE MAILED:

06/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/134,831

Applicant(s)

Mettke

Examiner

Stella Woo

Art Unit

2643



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 17, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2643

DETAILED ACTION

Drawings

1. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, credit card reader, printer and an access door in the manner depicted in the current Figure 2. Correction is required.

2. The proposed substitute sheet of drawings (substitute Figure 2), filed on April 17, 2000 has been disapproved because it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a housing incorporating a monitor, keyboard, and credit card swipe device such that the substitute Figure 2 does not remedy the objection to the drawings given in the last Office action and repeated above.

Art Unit: 2643

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The recitations of a “touch terminal” of claim 2, lines 1-3 and claim 7, lines 1-3; and the “durable enclosure for the CPU, monitor, internal modem and printer” of claim 4, lines 1-2 and claim 9, lines 1-2 are not supported by the original disclosure as filed on January 23, 1995.

The above new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

Applicant is required to cancel the new matter in the reply to this Office action.

Art Unit: 2643

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F") for the same reasons given in the last Office action and repeated below.

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

Art Unit: 2643

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);
means for accessing commercial on-line services and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 1 in that it does not *explicitly* recite software installed into the CPU to allow interaction with commercial on-line service providers and credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the commercial on-line service providers and credit card centers.

Regarding claim 2, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

Art Unit: 2643

Regarding claim 3, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 4, Exhibit F provides for a durable enclosure (heavy-duty steel cabinet; Exhibit F, second page, left-hand column, "Ergonomically Designed Cabinet").

7. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), as applied to claims 1-4 above, and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article").

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

Art Unit: 2643

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);
means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing

Art Unit: 2643

and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the kiosk information system of Exhibit E in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, Exhibit E provides for a durable enclosure (Exhibit E, photo of housing on first page).

Art Unit: 2643

Response to Arguments

8. Applicant's arguments filed April 17, 2000 have been fully considered but they are not persuasive.

Regarding the objection to Figure 2, applicant points to col. 1, lines 36-56 as providing support for the terminal housing incorporating a monitor, keyboard, and credit card reader.

However, this passage refers to various capabilities in prior U.S. patents to other inventors; it does not describe applicant's own invention as including a housing incorporating the depicted elements. Nowhere in the original specification is there any description of a terminal housing incorporating all the elements of Figure 2. Applicant further points to specific passages in U.S. patents to other inventors. Applicant cannot rely on references to other U.S. patents to provide support for subject matter missing from applicant's own written description.

Regarding the rejections of claims 1-4, 6-9 under 35 USC 112, 1st paragraph, applicant again points to other U.S. patents cited in the section entitled "Description of Prior Art" as providing support for the subject matter newly added to the original specification. However, it is the applicant's own written description of his invention which should clearly and fully describe the invention contemplated by the applicant. Although applicant has removed references to the "printer paper discharge chute" and "access door," there remains the added material in col. 2, lines 3-7 and col. 2, line 53 - col. 3, line 3 which describes a housing including therein a monitor, credit card reader swipe device, a keyboard, a printer and touch screen. These elements being

Art Unit: 2643

incorporated within a terminal housing or “durable enclosure” was not described in the original disclosure as a feature of applicant’s invention and, therefore, constitutes new matter.

In response to applicant's argument that there is no suggestion to combine the references (Exhibits E and F in the TouchNet protest), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Exhibit E describes a TouchFax terminal which clearly allows interaction with commercial on-line services (via touchscreen and computer modem; second page, second column, second paragraph) and with credit card centers (via credit card reader; second page, first column, second paragraph, lines 4-6). Exhibit E differs from claims 1-4 only in that it does not *explicitly* state the use of software installed into the CPU to carry out its disclosed communication operations. However, Exhibit F further describes a TouchFax terminal in which it is stated that software is installed into the CPU to carry out its communication functions (first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of installed software, as taught by Exhibit F to be a well known means in a TouchFax terminal for carrying out the communication operations, within the TouchFax terminal described in Exhibit E in order to carry out the disclosed communication operations.

Art Unit: 2643

Regarding applicant's argument that Exhibits E and F are not proper prior art, the examiner disagrees. Exhibit E is a magazine article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity," *published* in October 1992 by Allen Weiner in the magazine Interactive World. A published article in a magazine directed to interactive technology is clearly accessible to the public and to persons concerned with the art. Furthermore, MPEP 2128.02 states that a journal article or other publication becomes available as prior art on date it is received by a member of the public and, thus, "a magazine or technical journal is effective as of its date of publication." Exhibit F is a brochure made available to the public in 1991, well before the filing date of applicant's invention, and describing a product available for public use and sale by TouchFax Information Systems, Inc. Applicant has not provided evidence that Exhibit F was not accessible to the public.

Applicant further argues that Exhibit E lacks a "means for accessing commercial on-line services." The examiner contends that Exhibit E provides for accessing and retrieving documents from remote service providers (second page, second column, second paragraph, lines 9-13) and paying for such services via credit card reader (second page, first column, second paragraph) such that the on-line service provided in Exhibit E can be considered "commercial."

Regarding claims 6-9, applicant argues that "Exhibit E never discusses the Internet." However, the examiner relied upon the article by Rawn Shah, *not* Exhibit E, to show the desirability of accessing and interacting with the Internet from a kiosk terminal.

Art Unit: 2643

Applicant further argues that the Shah article is not proper prior art because “it is not indexed or catalogued in any library or other location accessible to the public.” However, an electronic publication need not be indexed or catalogued in a library to be considered as prior art. MPEP 2128 (section entitled “ELECTRONIC PUBLICATIONS AS PRIOR ART”) clearly states that “[a]n electronic publication, including an on-line database or Internet publication, is considered to be a ‘printed publication’ within the meaning of 35 USC 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates” and “[p]rior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted.” Therefore, the article by Shah describing suggestions for information kiosks and posted on the Internet can be considered as a “printed publication” within the meaning of 35 USC 102(a) and (b) and accessible to persons concerned with the kiosk art.

9. Applicant's arguments with respect to claims 6-9 (specifically, software for interfacing with credit card centers) have been considered but are moot in view of the new ground(s) of rejection.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

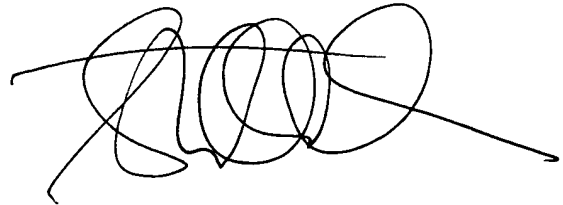
(703) 872-9314.

Art Unit: 2643

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:00 a.m. until 2:30 p.m., Monday through Friday.

June 8, 2001

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

**STELLA WOO
PRIMARY EXAMINER**